

4

CERTIFICATE OF MAILING: I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on June 26, 2001.



/ Ruth Montalvo Date: 06/26/01

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

EXAMINER: UNASSIGNED ATTY DOCKET #: 500582.20016
APPLICANTS: David R. SMITH, et al. GROUP ART UNIT: UNASSIGNED
SERIAL NO.: 09/729,562
FILING DATE: December 4, 2000
TITLE: SYSTEM AND METHOD FOR SINGLE-ENDED LINE ANALYSIS
FOR QUALIFICATION AND MAPPING

Commissioner for Patents
Washington, D.C. 20231

**PETITION UNDER 37 CFR § 1.47(a) TO ESTABLISH
DUANE EARECKSON'S REFUSAL TO SIGN A DECLARATION**

Sir:

I. STATEMENT OF FACTS

1. On December 4, 2000, the subject application was filed in the names of David R. Smith, Richard Liberman, Duane Eareckson, David Johnson and Paul Francis Wyar. An unexecuted Combined Declaration and Power of Attorney listing all of these inventors was filed with the subject application. A copy of the unexecuted Combined Declaration and Power of Attorney is attached hereto in Exhibit 1.

07/25/2001 TV0111 00000007 501529 09729562
01 FC:122 130.00 CH

2. Upon receiving a Notice to File Missing Parts of Nonprovisional Application from the United States Patent and Trademark Office for the subject application, the undersigned attorney sent a Combined Declaration and Power of Attorney (hereinafter "Declaration") for execution by the inventors to Mr. Phil Florenzo, Corporate Counsel for



Acterna, LLC, which is the assignee of the subject application. A copy of the unsigned Declaration is attached hereto in Exhibit 2.

3. Mr. Florenzo then had his assistant, Patty Tavernia, forward the Declaration to each of the inventors. The Declaration was executed by David R. Smith, Richard Liberman, David Johnson and Paul Francis Wyar. A copy of the Declaration as executed by these inventors is provided in Exhibit 3.

4. Ms. Tavernia has made several attempts to have Duane Eareckson execute the Declaration as demonstrated in the Declaration of Patty Tavernia which is provided in Exhibit 4. In particular, as stated in the Declaration of Patty Tavernia at paragraph 4, Ms. Tavernia spoke with Duane Eareckson on February 19, 2001 and informed him that the Declaration and a self-addressed Federal Express envelope were being sent to him for his execution as an inventor in the subject application.

5. Ms. Tavernia sent a letter including the Declaration and a self-addressed Federal Express envelope to Duane Eareckson on February 20, 2001. See the Declaration of Patty Tavernia at paragraph 4. A copy of Ms. Tavernia's February 20, 2001 letter, the Federal Express shipping slip for the package and the Federal Express shipping slip for the self-addressed Federal Express return envelope are provided in Exhibit A of the Declaration of Patty Tavernia.

6. Ms. Tavernia tracked the package and found out that it was delivered to Duane Eareckson on February 23, 2001 at 11:07 a.m. and that Duane Eareckson signed the Federal Express slip acknowledging receipt of the package. See the Declaration of Patty Tavernia at paragraph 5.

7. Ms. Tavernia did not receive an executed Declaration from Duane Eareckson. Thus, Ms. Tavernia called Duane Eareckson at his home and left a message on his answering machine on May 8, 2001. See the Declaration of Patty Tavernia at paragraph 6. Duane Eareckson did not return Ms. Tavernia's call and therefore, Ms. Tavernia sent another copy of the Declaration along with a new self-addressed Federal Express envelope to Duane Eareckson on May 8, 2001. See the Declaration of Patty Tavernia at paragraph 7. Copies of Ms. Tavernia's letter of May 8, 2001, the Federal Express shipping slip for the package sent on May 8, 2001 and the Federal Express shipping slip for the return envelope are provided in Exhibit B of the Declaration of Patty Tavernia.

8. Ms. Tavernia tracked the package and found out that it was delivered to Duane Eareckson on May 9, 2001 at 9:30 a.m. See the Declaration of Patty Tavernia at paragraph 8.

9. Ms. Tavernia did not receive an executed Declaration from Duane Eareckson subsequent to the Federal Express package she sent on May 8, 2001. Thus, Ms. Tavernia placed calls to Duane Eareckson's home on May 10, 2001 and May 14, 2001 and neither call was answered. Each time Ms. Tavernia left a message on Duane Eareckson's home answering machine asking him to confirm receipt of the package she sent on May 8, 2001. See the Declaration of Patty Tavernia at paragraphs 9 and 10.

10. Ms. Tavernia also called Duane Eareckson's home on May 22, 2001 and again, no one answered her call. As such, she left a message asking Duane Eareckson to give her a call. See the Declaration of Patty Tavernia at paragraph 11.

11. Duane Eareckson has yet to return any of Ms. Tavernia's calls or return an executed Declaration to Ms. Tavernia or Acterna, LLC. See the Declaration of Patty Tavernia at paragraph 12.

II. REQUIREMENTS OF APPLICABLE LAW TO BE REVIEWED

When an inventor refuses to join in an application by signing a Declaration, 37 CFR § 1.47(a) requires (i) a Declaration executed by available joint inventors, (ii) a petition including proof of the pertinent facts establishing the omitted inventor's refusal to sign, (iii) a fee as specified in 37 CFR § 1.17(h), and (iv) the last known address of the omitted inventor. For the reasons presented below, these four requirements of 37 CFR § 1.47(a) have been satisfied.

First, a Declaration listing David R. Smith, Richard Liberman, Duane Eareckson, David Johnson and Paul Francis Wyar was executed by David R. Smith, Richard Liberman, David Johnson, and Paul Francis Wyar and it is attached hereto in Exhibit 3 and is being concurrently filed herewith in the subject application.

Second, this petition includes a Declaration by Ms. Patty Tavernia, a representative of the assignee of the subject application, establishing Duane Eareckson's refusal or unavailability to sign the Declaration for the subject application (See Statement of Facts, ¶'s 4-11, supra). Duane Eareckson received two copies of the Declaration. However, Duane Eareckson has yet to return an executed Declaration to the assignee of the subject application or any employee of the assignee. These facts establish Duane Eareckson's refusal to sign the Declaration.

Third, the fee of \$130, as is required by 37 CFR § 1.17(h), has been included in the check attached hereto. The Commissioner is further authorized to charge Deposit Account No. 50-1529 with any additional fees required to comply with the requirements of 37 CFR § 1.47.

And fourth, the last known address of Duane Eareckson is 2521 Link Road,
Lynchburg, VA 24503.

III. ACTION REQUESTED

The subject action be accorded status under 37 CFR § 1.47 by the Special Program
Law Office and subsequently, the subject application be assigned to an Examiner and acted
on by the Examiner.

Respectfully submitted,
REED SMITH LLP

By: 

Eugene LeDonne - Reg. No. 35,930
375 Park Avenue, 17th Floor
New York, NY 10152
(P) 212-521-5402
(F) 212-521-5450
Attorney for Applicants